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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,622	01/08/2002	Marco Nahmias Nanni	07040.0116	9251

7590

06/17/2003

Finnegan, Henderson, Farabow,  
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EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 06/17/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/038,622

Applicant(s)

NANNI ET AL.

Examiner

Adrienne C. Johnstone

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) 36-57, 59 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-35 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 36-57, 59, and 60 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

As to applicants' continued argument concerning "serious" burden, applicants are reminded that the explanation of separate status in the art in paragraphs 6 and 7 of the restriction requirement (Paper Number 7) constitutes a *prima facie* showing of serious burden that applicants have yet to rebut by appropriate showings or evidence (MPEP 803); in any case, the separate status in the art due to recognized divergent subject matter among the three groups of tire claims is further supported by the International Search Report accompanying the Information Disclosure Statement filed January 8, 2002 which cites various references pertinent to some but not pertinent to others of the three groups of tire claims (tire characterized by substantially constant hardness, original claims 1-5; tire characterized by substantially constant elastic modulus, original claims 6-10; tire characterized by the composition, original claims 11-23; tire characterized by substantially constant hardness and elastic modulus, original claim 24).

### *Allowable Subject Matter*

2. The indicated allowability in substance of claims 31-35 and 58 is withdrawn in view of the newly applied rejection under 35 U.S.C. 112, first paragraph below. Once allowable subject matter is again determined for the elected invention, the examiner will consider rejoining the combination claim 54 if it incorporates all of the limitations of a claim allowable in substance.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

Art Unit 1733

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 31-35 and 58 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the tread underlayer having the specified variation in hardness by making the underlayer from an elastomer compound comprising reinforcing fibers and hardening resin, does not reasonably provide enablement for the tread underlayer having the specified variation in hardness by any other means. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The original disclosure does not describe any other way of obtaining the claimed variation in hardness in the tread underlayer, and one of ordinary skill in the art would not know how else to obtain this property without undue experimentation due to the high degree of unpredictability in the chemical composition arts. See MPEP 2164.06(b) and 2164.08.

#### *Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (703)308-2059. The examiner can normally be reached on Monday-Friday, 10:00AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703)308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9311 for regular communications and (703)872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

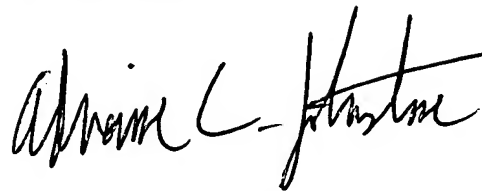
Application/Control Number: 10/038,622

Page 4

Art Unit 1733

Adrienne C. Johnstone  
Primary Examiner  
Art Unit 1733

Adrienne Johnstone  
June 16, 2003

A handwritten signature in black ink, appearing to read "Adrienne C. Johnstone". The signature is written in a cursive, flowing style with a large initial 'A' and a long horizontal stroke extending to the right.